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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,397	12/04/2000	Daniel Scott Fritsch	Z2285-5-6	6523

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3692

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/729,397	<b>Applicant(s)</b> FRITSCH ET AL.	
	<b>Examiner</b> Narayanswamy Subramanian	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This office action is in response to applicant's request for continued examination filed on July 28, 2006. Amendments to the specification made in the current communication have not been entered as discussed below. Claims 1-6 are currently pending in the application and have been examined. The rejections and response to arguments are stated below.

#### *Specification*

2. The amendment filed July 28, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Phrases such as "individual bid", "individual buy bid" and "individual sell bid" in paragraphs 32-34 of the specification are not supported by the description of the invention at the time of filing.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat,

Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1-6 include the limitations "graphically displaying an individual ask bid, graphically displaying an individual buy bid, graphically displaying a spread having a plurality of the incremental bid levels between the graphically displayed individual ask bid and the graphically displayed individual buy bid, and reconfiguring the scaled graph with the displayed individual ask bid, the individual buy bid". However, the specification does not provide written description disclosure to support the claimed limitations of "graphically displaying an individual ask bid, graphically displaying an individual buy bid, graphically displaying a spread having a plurality of the incremental bid levels between the graphically displayed individual ask bid and the graphically displayed individual buy bid, and reconfiguring the scaled graph with the displayed individual ask bid, the individual buy bid".

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in Such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1-6 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia (US Patent 6,272,474 B1) in view of Lupien et al (US Patent 5,845,266).

Claims 1-2, Garcia teaches a method utilizing a network computer system connectable to a plurality of monitors comprising the steps of: displaying an image of at least one scaled graph having incremental bid levels upon a computer monitor reflecting a range of monetary values (See Garcia Figure 5); graphically displaying an individual ask bid at a selected incremental bid level upon the scaled graph (See Garcia Figure 5, Abstract and Column 3 lines 22-27); graphically displaying an individual buy bid at a selected incremental bid level upon the scaled graph (See Garcia Figure 5, Abstract and Column 3 lines 22-27); and reconfiguring the scaled graph with the displayed ask bid and buy bid in response to new market information (See Garcia Figure 5, Abstract, Column 3 lines 22-27, Column 5 line 21 - Column 6 line 15 and claims 1-3). The bids and offers of market makers are individual bids and offers.

Garcia fails to explicitly teach the steps of graphically displaying a spread having a plurality of the incremental bid levels between an individual ask bid and an individual buy bid and reconfiguring the scaled graph with the spread in response to the spread decreasing to a select quantity justifying a reallocation of the incremental bid levels. However the limitation “in

response to the spread decreasing to a select quantity justifying a reallocation of the incremental bid levels” is interpreted as intended use of the reconfiguring step and hence not given patentable weight.

Lupien teaches the steps of graphically displaying a spread having a plurality of the incremental bid levels between an ask bid and a buy bid and reconfiguring the scaled graph with the spread in response to the spread decreasing to a select quantity justifying a reallocation of the incremental bid levels (See Lupien abstract, Column 5 lines 13-21, Column 6 lines 48-52, Column 7 lines 35-48, Column 11 lines 21-61, claims 3-5) and wherein the reconfiguration of the incremental bid levels is determined by a mathematical formula (See Lupien Column 10 lines 5-15).

Both Garcia and Lupien are concerned with helping users analyze the trend in the market and help traders with price discovery. It would have been obvious to one with ordinary skill in the art at the time of invention to modify the Garcia invention to include the disclosure of Lupien. The combination of the disclosures taken as a whole suggests that it would have helped the bidders make more informed decisions by considering the spread information and the price discovery provided by the combination.

Claims 3-4, Garcia teaches a method utilizing a networked computer system having a plurality of coupled monitors, the method comprising the steps of: displaying a graphical scale upon a monitor (See Garcia Figure 5); displaying an individual buy bid upon the graphical scale (See Garcia Figure 5, Abstract and Column 3 lines 22-27); displaying an individual ask bid upon the graphical scale (See Garcia Figure 5, Abstract and Column 3 lines 22-27). (Also see Garcia

Figure 5, Abstract, Column 3 lines 22-27, Column 5 line 21 - Column 6 line 15 and claims 1-3).

The bids and offers of market makers are individual bids and offers.

Garcia fails to explicitly teach the steps of displaying a plurality of incremental bid levels upon the graphical scale between the individual buy bid and the individual ask bid, wherein a quantity distribution and monetary valuation of each bid level is dependent upon a spread between the individual buy bid and the individual ask bid, and graphically redisplaying the graphical scale, the individual buy bid upon the graphical scale, and the individual ask bid upon the graphical scale in response to a narrowing of the spread between the individual buy bid and the individual ask bid with the entry of a new bid, wherein a new quantity distribution and a new monetary valuation of each incremental bid level is dependent upon the spread between the individual buy bid and the individual ask bid. The limitations “wherein a quantity distribution and monetary valuation of each bid level is dependent upon a spread between the individual buy bid and the individual ask bid” and “wherein a new quantity distribution and a new monetary valuation of each incremental bid level is dependent upon the spread between the individual buy bid and the individual ask bid” are interpreted as non-functional descriptive material because the step of displaying a plurality of incremental bid levels upon the graphical scale between the individual buy bid and the individual ask bid is performed regardless of the value of a quantity distribution and monetary valuation of each bid level. These limitations do not affect the step of displaying as currently claimed. Also the limitation “in response to a narrowing of the spread between the individual buy bid and the individual ask bid with the entry of a new bid” is interpreted as the intended use of the graphically redisplaying the graphical scale step.

Lupien teaches the steps of displaying a plurality of incremental bid levels upon the graphical scale between the individual buy bid and the individual ask bid, and graphically redisplaying the graphical scale, the individual buy bid upon the graphical scale, and the individual ask bid upon the graphical scale in response to a narrowing of the spread between the individual buy bid and the individual ask bid with the entry of a new bid, wherein a new quantity distribution and a new monetary valuation of each incremental bid level is dependent upon the spread between the individual buy bid and the individual ask bid (See Lupien abstract, Column 5 lines 13-21, Column 6 lines 48-52, Column 7 lines 35-48, Column 11 lines 21-61, claims 3-5) and wherein the step of graphically displaying the graphical scale is determined by a mathematical formula (See Lupien Column 10 lines 5-15).

Both Garcia and Lupien are concerned with helping users analyze the trend in the market and help traders with price discovery. It would have been obvious to one with ordinary skill in the art at the time of invention to modify the Garcia invention to include the disclosure of Lupien. The combination of the disclosures taken as a whole suggests that it would have helped the bidders make more informed decisions by considering the spread information and the price discovery provided by the combination.

Claims 5 and 6, Garcia and Lupien combined teach the features recited in these claims (See also discussion of claims 1-4 above). A host computer network, remote computers including display means for displaying graphs and communication network means are inherent in these disclosures.

***Response to Arguments***



9. In response to Applicant's arguments that Garcia does not describe a graph having incremental bid levels, an individual ask bid and an individual buy bid, the examiner respectfully disagrees. NASDAQ Level II data provides bid data and offer data for a market maker as discussed above. Figure 5 of Garcia for instance provides a graphical representation of this data for a market maker (Agent ABC).

In response to Applicant's arguments that Lupien does not teach any rescaling of graph as prices change, the examiner respectfully disagrees. For instance Lupien discloses that range and scale of each axis can be automatically set by the system (Lupien Column 6 lines 48-52). Also price range parameter can be set on an absolute or relative basis (Lupien Column 7 lines 35-47). Lupien also discloses that the displays could change according to market and trader requirements (Lupien Column 12 lines 17-26).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Garcia and Lupien are concerned with the problem of helping users analyze the trend in the market and help traders with price discovery. It would have been obvious to one with ordinary skill in the art at the time of invention to modify the Garcia invention to include the disclosure of Lupien. The combination of the disclosures taken as a whole suggests that it would

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have helped the bidders make more informed decisions by considering the spread information and the price discovery provided by the combination.

Applicant's other arguments with respect to the examined claims have been considered but are not persuasive.

### **Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian  
Primary Examiner

October 14, 2006